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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,423	03/14/2001	Gene E. Nacey	569.005	3458

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FERENCE & ASSOCIATES LLC  
409 BROAD STREET  
PITTSBURGH, PA 15143

EXAMINER

PASS, NATALIE

ART UNIT	PAPER NUMBER
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3626

MAIL DATE	DELIVERY MODE
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07/31/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/808,423	<b>Applicant(s)</b> NACEY, GENE E.	
	<b>Examiner</b> Natalie A. Pass	<b>Art Unit</b> 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 4 May 2007+
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 39-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 39-76 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to the amendment filed 4 May 2007. Claims 39, 45-47, 50, 52, 55, 57-62, 65-68, 71, 73-76 have been amended. Claims 1-38 have been previously cancelled. Claims 39-76 remain pending.

### ***Claim Rejections - 35 USC § 112***

2. The rejection of claims 39-76 under 35 U.S.C. 112, first paragraph, for containing new matter is hereby withdrawn due to the amendment filed 4 May 2007.

3. The rejection of claims 39, 45-47, 50, 52, 55, 57-62, 65-68, 71, 73-76 under 35 U.S.C. 112, second paragraph, for being indefinite is hereby withdrawn due to the amendment filed 4 May 2007.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 39-40, 44-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolawa et al., U.S. Patent Number 6, 370, 513 in view of Cosentino et al., U.S. Patent Number 6,

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290, 646 for substantially the same reasons given in the previous Office Action (paper number 20060915). Further reasons appear hereinbelow.

(A) As per the amendments to claims 39, 45-47, 50, 52, 55, 57-62, 65-68, 71, 73-76, these appear to have been made merely to correct minor typographical or grammatical errors in the claim language or to correct rejections under 35 USC § 112. While these changes render the language of the claim smoother and more consistent, they otherwise affect neither the scope and breadth of the claim as originally presented nor the manner in which the claim was interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 20060915, section 10, pages 5-12), and incorporated herein.

(B) Claims 40, 44, 48-49, 51, 53-54, 56, 63-64, 69-70, 72 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 20060915, section 10, pages 5-12), and incorporated herein.

6. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kolawa et al., U.S. Patent Number 6, 370, 513 in view of Cosentino et al., U.S. Patent Number 6, 290, 646 as applied to claim 39 above, and further in view of Petot, et al. article: "An artificial intelligence system for computer-assisted menu planning," Sept. 1998, hereinafter known as Petot for substantially the same reasons given in the previous Office Action (paper number 20060915). Further reasons appear hereinbelow.

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(A) Claim 41 has not been amended and is rejected for the same reasons given in the previous Office Action (paper number 20060915, section 11, pages 12-13), and incorporated herein.

7. Claims 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolawa et al., U.S. Patent Number 6, 370, 513 in view of Cosentino et al., U.S. Patent Number 6, 290, 646 as applied to claim 39 above, and further in view of Brown, U.S. Patent Number 6, 168, 563 for substantially the same reasons given in the previous Office Action (paper number 20060915).

Further reasons appear hereinbelow.

(A) Claims 42-43 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 20070120, section 12, pages 14-15), and incorporated herein.

### ***Response to Arguments***

8. Applicant's arguments filed 4 May 2007 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 4 May 2007.

(A) At pages 9-12 of the 4 May 2007 response, Applicant argues the rejections under 35 U.S.C. 112, first paragraph and clarifies the new matter issues and specifically points out support for the newly added limitations in the originally filed specification and claims. These arguments are persuasive, and Examiner thanks Applicant for the detailed analysis, and has accordingly withdrawn the rejections.

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(B) At pages 12-14 of the 4 May 2007 response, Applicant apparently argues that there is no suggestion to combine the references. In response to Applicant's argument, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Furthermore, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. And although the motivation or suggestion to make modifications must be articulated, it is respectfully submitted that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that the Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re Delisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257,

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1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti* et al 192 USPQ 278

(CCPA) that:

- (i) obvious does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In *In re Conrad* 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

In the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references is accompanied by select portions of the respective reference(s) which specifically support that particular motivation. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

Moreover, Applicant apparently ignores the evidence given by the Examiner, namely, recitations of specific portions of the applied reference, express articulation of the combinations and the motivations for combinations, as well as the scientific and logical reasoning of one

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skilled in the art at the time of the invention, as given in the prior Office Action (see paper number 20060915). Note, for example, the motivations explicitly stated at paragraph 3 of page 8 of the previous Office Action (i.e., " ... with the motivations of enabling the "monitoring and transmitting ..."), and at the last paragraph on page 13 of the prior Office Action (i.e., " ... with the motivations of "planning daily menus in accordance with the nutrition needs ... ") and at paragraph 1 on page 14 in the prior Office Action (i.e., " ... with the motivations of "providing a simple and inexpensive system for remotely ... ").

As such, it is respectfully submitted that Applicant appears to view the applied references separately, without considering the knowledge of average skill in the art, and further fails to appreciate the breadth of the claim language that is presently recited.

Consequently, it is respectfully submitted that contrary to Applicant's allegations, the features that Applicant disputes are clearly within the teachings of the applied references and that Applicant fails to properly consider the clear and unmistakable teachings of the applied references, as illustrated above.

In response to Applicant's assertions at pages 12-14 of the 4 May 2007 response, that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to Applicant's assertions at the paragraph bridging pages 14-15 of the 4 May



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2007 response, that a “nutritionist” is not a “food service professional,” and that Applicant’s disclosure at page 13, line 17 to page 14, line 1 of the Specification confirms this, Examiner respectfully disagrees. At the cited lines in the Specification, Applicant discloses “[i]n another preferred embodiment, additional databases are maintained permitting new users to chat with experienced users. Such users would include both managers, chefs, and nutritionists.” It is unclear how this disclosure either confirms or denies that “nutritionist” is or is not a “food service professional.” In the absence of any clear definition of “professional” in Applicant’s disclosure, Examiner notes dictionary definitions, such as “professional: a person who has a job that needs skill, education, or training” (Cambridge Dictionary of American English), and “following occupation as paid job: engaged in an occupation as a paid job rather than as a hobby” (MSN Encarta Dictionary). Examiner notes that the “nutritionist” described in the Cosentino reference works in “food service” in a medical environment, and, additionally, can be characterized by both of these definitions. As such, Examiner concludes that Cosentino’s nutritionist can be used to teach a “food service professional.”

In response to Applicant's assertions at page 15 of the 4 May 2007 response, that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, and that the combination of references was improper, Examiner respectfully disagrees, and notes that these issues were discussed earlier in this Office Action.

With regard to Applicant's contentions on pages 15-16 of the 4 May 2007 response that Examiner's interpretations of the claim limitations is incorrect, it should be noted that Examiner has given the previously claimed elements their broadest reasonable interpretation, as required by MPEP § 2106, which states: Office personnel are to give claims their broadest reasonable

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interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). See also *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)

In response to Applicant's assertions at pages 16-18 of the 4 May 2007 response, that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, and that the combination of references was improper, Examiner respectfully disagrees, and notes that these issues were discussed earlier in this Office Action.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks  
Washington D.C. 20231

**or faxed to:** (571) 273-8300.

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For formal communications, please mark  
"EXPEDITED PROCEDURE".

For informal or draft communications, please label  
"PROPOSED" or "DRAFT" on the front page of the  
communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Natalie A. Pass

July 19, 2007

  
C. LUKE GILLIGAN  
PRIMARY EXAMINER  
TECHNOLOGY CENTER 3600